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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT PAPER NUMBER

3676

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,867

Applicant(s)

LEMLEY ET AL.

Examiner

Gary Estremsky

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15 and 17-34 is/are rejected.
- 7) ☒ Claim(s) 13 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

In the Abstract

Line 12 - "received" should be replaced with -receive-.

Line 15 - "and" should be deleted.

Appropriate correction is required.

Claim Objections

1. Claims 5 and 26-34 are objected to because of the following informalities :

Claim 5; line 2 - "and" should be replaced with -an-.

Claim 5; line 4 - "engaging" should be replaced with -engages-.

All claims after first claim 25 are objected to for being improperly numbered. They have been renumbered to be consecutive beginning with -26- and continuing through -34-. Those claims are referred to accordingly hereinbelow.

Claim 29; line 2 - "and" should be replaced with -an-.

Claim 29; line 4 - "engaging" should be replaced with -engages-.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 6, 11-22, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As regards claims 11, 14, it is not clear what is included by limitation of handle rotatably engaging a cam plate". 'As best understood', the disclosed handle rotates with, not relative to the cam plate. In that respect the claim language is confusing/contrary to the disclosed invention whereby one of ordinary skill in the art is not reasonably apprised of the claim scope.

Similar consideration applies to claims 5, 27 limitation of "handle rotatably engages the axle".

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,508,087 to Lemley.

While the claims are not exact duplicates, one of ordinary skill in the art would recognize the claimed invention to be the same or obvious variant of the same invention. For example, where “two rods” are now claimed, the limitation is not patentably distinguished from Patent claim of “three rods” since ‘three rods’ *inherently* includes ‘two rods’. The claim is not limited to –only two rods– for example. In this case, the fact that the Patent claim discloses additional structure not presently claimed is irrelevant.

Regardless, one of ordinary skill in the art would have considered the choice of two or three rods to be an obvious design choice or engineering expedient since prior art indicates that both arrangements are well known in the art for performing the same function; ‘three rods’ providing additional perimeter security but generally adding to cost for example. One of ordinary skill in the art would have more than a reasonable expectation of success in reducing from three rods to two rods as a cost-saving measure for example since such modification would not otherwise affect function of the device. It has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

5. Claims 1-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,592,155 to Lemley.

While the claims are not exact duplicates, one of ordinary skill in the art would recognize the claimed invention to be the same or obvious variant of the same invention. For example, where “two rods” are now claimed, the limitation is not patentably distinguished from Patent claim of “three rods” since ‘three rods’ *inherently* includes ‘two rods’. The claim is not limited to –only two rods– for example. In this case, the fact that the Patent claim discloses additional structure not presently claimed is irrelevant.

Regardless, one of ordinary skill in the art would have considered the choice of two or three rods to be an obvious design choice or engineering expedient since prior art indicates that both arrangements are well known in the art for performing the same function; ‘three rods’ providing additional perimeter security but generally adding to cost for example. One of ordinary skill in the art would have more than a reasonable expectation of success in reducing from three rods to two rods as a cost-saving measure for example since such modification would not otherwise affect function of the device. It has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4, 5, 8-11, 21, 23-25, 28, 29, and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,029,909 to Bungler.

Bungler '909 teaches Applicant's claim limitations including : a "housing" - 13, a "door" - as described, "two rods" - 25,26, "two rod receivers" - col 2; line 39, a "handle" - exposed portion of 21, a "linkage" - including lever elements and pins connecting the exposed handle to the lock rods, all arranged as set forth in the claim.

As regards claim 5, Bungler '909 teaches an "axle" at 19 and portion of 20 particularly between 27 and 23 reads on "cam plate" limitation which must be interpreted broadly since Applicant's disclosed 'cam plate' does not function as a 'cam', i.e., convert rotational movement of one part to linear movement of a second part via sliding 'cam' surfaces of the parts.

As regards claim 8, openings in the housing read on broad limitation of "rod guides" where limitation of "proximate" is broad since it does not set forth any particular structural arrangement or range of distance that can be relied upon to patentably distinguish from structure of the prior art where the reference for example has a housing that is inherently 'proximate' the periphery of the door.

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As regards claim 10, the portions of the housing at its top and bottom flanges that is physically between each rod 25,26 and plate 17 reads on limitation of "anti-torque spacers" since that structure inherently prevents the linkage from being torqued out-of-plane to plate at 16 or 17. The claim does not define any particular structure that can be relied upon to patentably distinguish from the structure of the prior art. While Applicant is free to use functional language and statements of intended use to define the structure of the claimed product; such recitations often result in broad limitations at best. See MPEP 2114.

As regards claim 11, Bunker '909 teaches "locking tab" - 45.

8. Claims 1-5, 7-10, 21-29, and 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,088,548 to Behrens.

Behrens's '548 teaches Applicant's claim limitations including : a "housing" - including the hub portion mounted to the door and providing bearing for axle 18, a "door" - 3, "two rods" - 10,10, "two rod receivers" - including 12,12 and adjacent recess structure, a "handle" - 21, a "linkage" - including 10b,15,16, all arranged as set forth in the claim.

As regards claim 3, Behrens '548 teaches "gasket" 6.

As regards claim 4, although the "front panel" of the 'housing' of Behrens '548 is not illustrated as *being* flush mounted in the door, it is nonetheless, inherently "adapted to flush mount to the exterior of a door" having an appropriate recess, etc.. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the

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ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchison, 69 USPQ 138.

As regards claim 8, parts 11 teach limitation of "rod guides".

As regards claim 10, parts 10b separate parts 15,25 to create a rigid structure with respect to the plane of the door. The claim limitation does not define any structure that can be relied upon to patentably define from the prior art.

As regards claim 26, 10a is shown in Fig 1 to comprise at least two edges that define a 'taper'. As shown in Fig 2, 10a is shown to comprise at least two edges that define a taper in a perpendicular plane whereby the bolt 10a is disclosed to have four tapered edges, anticipating claim for "three tapered edges".

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 14, 17, 19-21, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,029,909 to Bunger in view of U.S. Pat. No. 3,088,548 to Behrens.

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Bunger '909 discloses the claimed invention except for a "gasket".

However, it is well known in the art to provide a door with a gasket to seal it to its jamb as shown by Behrens '548 for example. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the door of Bunger '909 with a gasket as taught by Behrens '548 in order to seal the door. One of ordinary skill in the art would have more than a reasonable expectation of success since the proposed modification would not otherwise affect function of the device.

As regards claim 18, although the handle of Bunger '909 appears to be integrally formed with the balance of the lever, it would have been an obvious design choice or engineering expedient for one of ordinary skill in the art at the time of the invention to form the handle separately and attach it to the balance of the lever by a weld to allow the handle to be made separately. One of ordinary skill in the art would have more than a reasonable expectation of success since the proposed modification would not otherwise affect function of the device and integrally forming two parts as one or separately forming and making integral via welding are well known equivalents in the art. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Further functional portion of the claim, "whereby said handle separates from the axle if excessive force is exerted on the handle" does not define over the structure of the reference either as it is disclosed or modified since it amounts to little more than a statement of intended use and does not clearly define any particular structure, size, or arrangement that

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can be relied upon to patentably define from well known structure of the prior art.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Ex parte Masham, 2 USPQ2d 1647 (1987).

11. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,029,909 to Bunger.

Although the handle of Bunger '909 appears to be integrally formed with the balance of the lever, it would have been an obvious design choice or engineering expedient for one of ordinary skill in the art at the time of the invention to form the handle separately and attach it to the balance of the lever by a weld to allow the handle to be made separately. One of ordinary skill in the art would have more than a reasonable expectation of success since the proposed modification would not otherwise affect function of the device and integrally forming two parts as one or separately forming and making integral via welding are well known equivalents in the art. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Further functional portion of the claim, "whereby said handle separates from the axle if excessive force is exerted on the handle" does not define over the structure of the reference either as it is disclosed or modified since it amounts to little more than a statement of intended use and does not clearly define any particular structure, size, or arrangement that

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can be relied upon to patentably define from well known structure of the prior art.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Ex parte Masham, 2 USPQ2d 1647 (1987).

12. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,029,909 to Bunger in view of U.S. Pat. No. 786,586 to Moreland.

Although the arrangement of Bunger '909 is disclosed for use with a lock, the reference teaches the claimed invention except for a "circular lock". Moreland '586 teaches that it is well known in the art to provide a circular lock. It would have been an obvious design choice or engineering expedient for one of ordinary skill in the art to use a circular lock such as the one disclosed by Moreland '586 with the device of Bunger '909 in order to prevent breakage by twisting as disclosed by Moreland '586. One of ordinary skill in the art would have more than a reasonable expectation of success since the proposed combination would not otherwise affect the function of the device of Bunger '909.

Allowable Subject Matter

13. Claims 13 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 2,209,727 to Gibson.

U.S. Pat. No. 4,046,410 to Connell.


U.S. Pat. No. 5,110,164 to Whiteman.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 703 308-0494. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Estremsky
Primary Examiner
Art Unit 3676